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EXAMINER

CADUGAN, ERICA E

ART UNIT

PAPER NUMBER

3722

MAIL DATE

DELIVERY MODE

11/13/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/994,741	Applicant(s) BLATTNER ET AL.	
	Examiner Erica E. Cadugan	Art Unit 3722	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 August 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 22-32 is/are pending in the application.
- 4a) Of the above claim(s) 28,29,31 and 32 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 22-27 and 30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Election/Restrictions

2. Newly submitted claims 28-29, and, as best understood, claims 31-32, are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: it is noted that claim 28 appears to be directed to the species of Figure 5, for example, and that claim 29 appears to be directed to the species of Figure 4. Additionally, as best understood, it appears that claims 31 and 32 involve the use of multiple binding elements for a single brochure, which would not apply to the embodiment or species of Figure 3. However, previously examined were claims that were generic, as well as claims drawn to the species of Figure 3, wherein a single wire binding element that corresponds to the width of the brochure is used (see at least previous claims 6 and 15, for example). In other words, no claims to the species of Figures 4 and 5 have been previously submitted or examined.

The species are independent or distinct because claims to the different species recite the mutually exclusive characteristics of such species. In addition, these species are not obvious variants of each other based on the current record.

There is an examination and search burden for these patentably distinct species due to their mutually exclusive characteristics. The species require a different field of search (e.g., searching different classes/subclasses or electronic resources, or employing different search queries); and/or the prior art applicable to one species would not likely be applicable to another

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species; and/or the species are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the species unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other species.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 28-29, and, as best understood, claims 31-32 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

As a side note regarding new claims 31-32, which have been withdrawn, it is noted that claims 31-32 are being interpreted as best understood because firstly, it is noted that the specification as originally filed does not appear to support a process step of “determining a number of the individual wire binding elements to be maximally selected, in dependence upon the format of the brochure to be bound”, and secondly, it is unclear precisely what is meant by this limitation, in particular with regards to the “maximally selected” aspect, and particularly noting that it is unclear whether the claim refers to a maximum number of wire binding elements

that are to be produced for a given production run of a particular brochure format, or to the maximum number of wire binding elements that will fit into a particular length of brochure being produced, or indeed precisely what is intended.

Response to Amendment

3. The amendment filed August 28, 2007 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: in the amended paragraph 022, Applicant now indicates that U.S. patent application Ser. No. "09/994,743" is the previously-un-numbered application titled "APPARATUS AND METHOD FOR SEGMENTED BENDING OF WIRE BINDING ELEMENTS" that was filed on the same date as the present application, naming Hans-Peter Wurschum as inventor. However, Examiner notes that no inventor by the name of Hans-Peter "Wurschum" is listed as an inventor in the 09/994,743 application, and thus, the addition of the serial number 09/994,743 in the amended paragraph 022 constitutes new matter. It is noted that 09/994,743 does list a "Hans-Peter Wuerschum" as an inventor (note the difference in spelling of the last name).

Applicant is required to cancel the new matter in the reply to this Office Action.

Specification

4. The disclosure is objected to because of the following informalities: in paragraph 0022 (page 6 of the specification as originally filed), the application mentions a U.S. patent application (titled "APPARATUS AND METHOD FOR SEGMENTED BENDING OF WIRE BINDING ELEMENTS"), and list (as filed) the serial number as x/xxx,xxx. The amendment of 8/28/07

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changes the xx/xxx,xxx designation to 09/994,743, which is currently new matter, as explained above. The specification should be updated to reflect the actual serial number. Care should be taken to avoid the entry of new matter, noting that if multiple applications by the listed inventor with the same listed titles were filed on the date indicated (beyond the two applications cited in paragraph 0022), narrowing that to a specific application by serial number would constitute new matter.

Additionally, the addition of the serial number 09/994,742 necessitates an objection to the specification, as the specification was not updated to reflect the status of this application. In the instant case, application 09/994,742 is abandoned, and thus, language such as --, now abandoned,-- should be added after "09/994,742" in paragraph 022.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 22-27 and 30 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Specifically, in new claim 22, line 1, the claim sets forth a process for "producing brochures in any formats and thicknesses...". While paragraph 001 of the specification as

originally filed does explicitly state that the process is for producing brochures in “any thickness”, the specification as originally filed does not appear to provide support for the limitation regarding the process being for producing brochures in “any” formats. It is noted that a teaching of varying a format (such as is taught in paragraph 015, for example) of the produced brochures is not the same thing as a teaching that “any format” can be produced.

Additionally, new claim 22, lines 5-6, sets forth the limitation of “producing at least one wire bending element with random loop length and loop distance as required”. However, it is noted that the specification as originally filed does not appear to support a teaching of “random loop length and loop distance” as now claimed.

Additionally, claim 30 sets forth a step of determining a production parameter of the wire binding element selected from a limited group including “diameter of the wire binding elements formed into the closed ring-like binding” with an electronic control device. However, the specification as originally filed does not appear to teach this feature.

7. Claims 22-27 and 30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term “loosely binding” in claim 22 (last two lines) is a relative term which renders the claim indefinite. The term “loosely binding” is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. It is noted that the abstract as originally filed provides a teaching for a process for producing bound documents of the type wherein several sheets are “loosely bound”, and thus, the limitation does not constitute “new

matter”. However, the specification as originally filed does not provide any guidance for determining what is meant by the term “loosely binding”, i.e., how loose is loose?

Claim 22, penultimate line, recites the limitation "the wire binding element ". There is insufficient antecedent basis for this limitation in the claim (previously “at least one...”). It is noted that this is not the only such occurrence in the claims, and Applicant is required to review the claims and correct any further such instances. For example, see at least claim 23, line 2.

Claim 30, last two lines, sets forth the limitation “the wire binding elements formed into the closed ring-like binding”. However, this limitation lacks sufficient antecedent basis in the claim. Note that claim 30 depends from claim 22, which sets forth “at least one wire binding element”, but does not set forth a) a plurality of wire binding “elements” and b) any wire binding element that is formed into a closed ring-like binding.

Claim Rejections - 35 USC § 102

8. Claims 22-23, 25, and 27, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Pat. No. 4,558,981 to Fabrig.

Fabrig teaches a method for producing a bound stationary article, such as a steno pad, book, calendar, or like commodity, considered a “brochure” as broadly claimed (see at least col. 1, lines 10-26, for example).

Noting 1) that steno pads, books, and calendars are generally different shapes, sizes, and thicknesses and 2) that Fabrig uses variables (rather than concrete numbers) to describe parameters relative to the length or width dimension of the articles being bound (see at least col. 3, line 41 through col. 4, line 17), thus indicating that such dimension can be varied, it appears

that Fabrig teaches that the bound articles that Fabrig's method is capable of producing include brochures in a variety of formats and thicknesses.

Additionally, it is noted that whatever format and thickness is taught by Fabrig (such as the format/thickness shown in Figure 1, for example) is within the claimed range of "any format and thickness".

Fabrig's method includes a step of providing a plurality of perforated superposed sheets 14 at binding station G (see the upper right portion of Figure 1 and at least col. 6, lines 23-49, for example). Note that the perforations 16 are located in a row at the edge or "margin" of the sheets (see at least Figure 1, and col. 7, lines 1-3, for example).

Additionally, Fabrig teaches producing wire binding elements from a supply 2 of wire 1 that is fed to a bending station A, where it is formed into a flat, multiple looped binding element 3 (see Figures 1 and 1a, for example, though it is noted that at least new independent claim 22 and many of the dependent claims do not now limit the binding element to a "flat" binding element). It is noted that, as broadly claimed, the selected loop length and distance is considered to be "random" in that it is selected or chosen or narrowed down so as to correspond to the required loop length and distance for a particular brochure that is being produced. As best understood, it appears that any loop length and distance could be considered "random", as broadly claimed, noting that it can be considered to be "randomly" chosen.

The binding element 3 is cut to a desired length (Figure 1 shows the use of "skip" or "composite" binding elements wherein plural cut binding elements 7a-7c, 7d-7f are used on a single brochure, and re **claim 27**, Figure 4 shows an embodiment wherein a single cut binding element 707a or 707b corresponding to a width of the brochure is used on a single brochure, see

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also col. 12, lines 35-41, for example), thus resulting in a “tailoring” of the binding element to a particular format of brochure. Note also that the wire binding element is considered inherently to be “tailored” (as broadly claimed) to a respective format and thickness of brochure, noting that if it wasn’t so “tailored”, or produced to the desired width/length and/or thickness of brochure being produced, a faulty brochure would be produced, i.e., the wire binding element would be too long or too short, wouldn’t match up to the perforations, or might be too thin or too thick for the number of pages being bound.

Further note that upon a stack of perforated sheet-like printing materials 14 being fed to station G, all of the loops of a particular binding element are inserted in the perforations of a particular stack at the same time (though this feature is not now claimed after the amendment of August 28, 2007), and are then closed or “bent” into a “ring-like binding” (see station G in Figure 1 as well as col. 10, line 41 through col. 11, line 14, as well as col. 12, lines 16-34, for example).

Note that, as broadly claimed, the insertion of the looped binding elements into the perforations is considered to occur “immediately after” the producing of the binding elements, particularly noting that the production is a continuous in-line operation that does not rely on a supply of pre-formed looped binding elements (see at least Figures 1 and 4, for example).

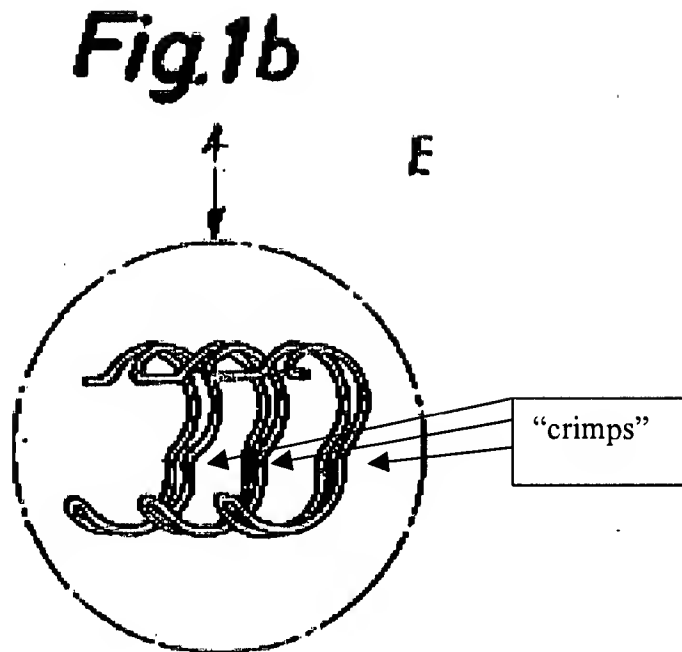
Re claim 23, claim 23 sets forth “additionally tailoring the wire binding element to be produced to the row of perforations”. It is further noted that, as broadly claimed, there are many ways in which the loops taught by Fabrig can be considered to be “tailored” so as to “be produced to the row of perforations”. Firstly, note that if the loops weren’t produced or “tailored” to have the appropriate configuration to match up with the perforations, the binding

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operation at station G described above would not be able to occur because the loops would not be at the appropriate locations to pass through the perforations. Secondly, it is noted that by virtue of the fact that Fabrig teaches that either “skip” binding using plural binding elements per brochure (Figure 1) or binding using one binding element per brochure (Figure 4) can be used as described previously, the selection of one versus the other is a way of “tailoring” the looped binding element to complement the perforations. Thirdly, the act of binding itself is a “tailoring” or manipulation of the looped binding element to make it complement the perforations. Fourth, note that the mere act of producing a binding element that is the appropriate size to match up with a particular set of perforations is itself an act of “tailoring” the binding element to complement the perforations. These are just a few ways in which Fabrig can be considered to meet the present claim language of claim 23 (as well as in claim 22).

Additionally, the binding of the brochures is considered to be “loose”, as broadly claimed, noting, for example, that it is inherently possible to unbind the sheets merely by unbending the loops of the wire binding element.

Re claim 25, it is noted that at least the section so indicated in the reproduction of Figure 1b below can be considered to be a “crimp” that is “formed” in a loop of the looped binding element.



Noting that the wire begins Fabrig's manufacturing process shown in Figure 1 as unbent wire 1 that is then passed through bending station A to bend the wire into a flat comb-like body 3, and then into a bending machine B to transform the flat comb-like body into the configuration 4 shown in Figure 1b, whatever structure is inherently present in the bending tooling of Fabrig to produce the crimped configuration shown in Figure 1b from the unformed wire 1 is considered to be the claimed "crimping device" of claim 25.

Claim Rejections - 35 USC § 103

9. Claim 24, as best understood, is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Pat. No. 4,558,981 to Fabrig in view of Applicant's Admission of Prior Art (hereinafter AAPA).

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Fabrig teaches all aspects of the presently-claimed invention as set forth in the above rejection(s) based thereon.

Additionally, regarding claim 24, it is noted that as broadly claimed, the format and thickness of a brochure to be bound must be “determined” before any such brochure can be produced.

Furthermore, re the step of “subsequently setting a production parameter for the wire bending element with an electronic control device” as set forth in claim 24, it is noted that at least col. 5, lines 49-68 provides a teaching of the use of a signal generating device, such as a variable resistor or potentiometer, which is used to “regulate” (i.e., “set” as claimed) “the speed of the machine at the first bending station A...”. It is noted that a signal generating device such as a resistor or potentiometer is “electronic”, and serves to control at least the production parameter of the speed of the machine at the first bending station, for example, which production parameter is a production parameter for the wire binding element since the first bending station is used in the production of that wire binding element.

Furthermore re claim 24, it is noted that, as broadly claimed, the Fabrig manufacturing stations A, B, C, D, E, F, G, etc. are all considered to be “mechanically connected” via the conveyance of the articles therebetween as shown in Figure 1.

Additionally, plural ones of the production devices are “electronically connected” as described in at least col. 5, lines 59-68, for example.

Also re claim 24, note that the “bending”, “cutting”, “feeding”, “inserting”, and “subsequently bending” steps set forth in portion b) of the claim have all been described above.

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Furthermore, re the step of “feeding” the “wire” 1 “from at least one wire supply having a wire spool” to the wire bending device A, Fabrig does teach that the wire 1 is supplied or “conveyed” to wire bending device A from a “barrel or another suitable source of wire” 2 (Figure 1, col. 5, lines 9-10), but does not explicitly teach that the “barrel or another suitable source of wire” is in the form of a “wire spool” as claimed.

In the previous Office Action (mailed 5/29/2007), Examiner took Official Notice as follows:

Re the supply of the wire being from a “wire spool”, Examiner takes Official Notice that the use of a “wire spool” as “another suitable source of wire” to supply wire to a wire processing arrangement is well known and widely used in industry, and provides the known benefit of being a readily available “off-the-shelf” way of obtaining wire.

This assertion (that the use of a “wire spool” as “another suitable source of wire” to supply wire to a wire processing arrangement is well known and widely used in industry and provides the known benefit of being a readily available “off-the-shelf” way of obtaining wire”) is taken to be admitted prior art because Applicant did not previously traverse the Examiner’s assertion. See MPEP section 2144.03, section C, for example.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have substituted a well-known (as admitted by Applicant) wire spool for the generic “another suitable source of wire” as taught by Fabrig for enabling the wire to be easily and readily obtained “off-the-shelf” in the manner in which it is to be supplied to the system of Figure 1 of Fabrig’s device, as would be a well-known benefit of using wire from a spool, as admitted by Applicant, as described previously.

10. Claim 26, as best understood, is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Pat. No. 4,558,981 to Fabrig as applied to at least claims 22 and 25 above, and further in view of U.S. Pat. No. 2,130,318 to Cruzan.

Fabrig teaches all aspects of the presently-claimed invention as set forth above, but is silent about whether the “crimp” or “crimps” labeled above are formed “loop by loop, with a single bending die”.

Cruzan teaches a wire deforming machine, wherein a flat looped or zig-zag stock 10 is fed into the machine (see Figures 1 and 5 and page 1, right column, lines 21-26, for example). Cruzan explicitly states that the formed stock may be kept in continuous lengths and severed into desired lengths at any subsequent time, or it can be severed in the shown machine, and Cruzan further teaches that the machine shown may be readily combined with or placed in-line with existing equipment (see at least page 3, left column, lines 57-74, for example). Furthermore, it is noted that Figure 3 is a vertical side section of Figure 1, that Figure 4 is a view along line 4-4 of Figure 3, and that Figure 5 is a view along line 5-5 of Figure 3. Upper die 56 crimps or creases one loop at a time at 72 via 71 (see Figures 3-5 and page 2, left column, line 30 through page 2, right column, line 16, for example, noting that 71 is the creasing or crimping part of the die 56).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have utilized a machine such as the one taught by Cruzan that crimps the loops one by one and also serves to form the loops into a “C” shape for the generic bending machine B taught by Fabrig which also serves to crimp and form the loops into a C, particularly since Cruzan teaches that the bending machine can be readily combined with existing equipment as described previously, and for the purposes of providing such a machine that is able to be

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“operated at high speed and produce a uniform high grade product” and one in which the material feed is smooth, all as explicitly taught by Cruzan in at least page 2, left column, lines 35-48, for example).

11. Claim 30, as best understood, is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Pat. No. 4,558,981 to Fabrig as applied to at least claim 22 above, and further in view of U.S. Pat. No. 5,042,343 to Boyadjian.

Fabrig teaches all aspects of the presently-claimed invention as set forth above.

However, Fabrig does not explicitly teach the step of “determining a production parameter of the wire binding element selected from the group consisting of wire diameter, wire length, and diameter of the wire binding elements formed into the closed ring-like binding, with an electronic control device” as set forth in claim 30.

However, Boyadjian teaches a cutting device 6 for cutting a strand 2 of a formed wire comb-type binding element (see at least Figure 1 and col. 1, lines 5-23) to a desired length (see at least col. 1, lines 40-45, for example). The device includes sensors 19, 20, which are connected to a processor 21, which constitutes the claimed “electronic control device” that “determines” the “production parameter” of wire length (see at least Figure 1 and col. 2, lines 27-45, for example) of the wire binding element being cut by the cutting mechanism 6.

Therefore, particularly since Fabrig is silent as to the particulars of the structure of the cutting or severing station C, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have either substituted the cutting arrangement taught by Boyadjian for the severing arrangement C taught by Fabrig or to

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have added the sensors and processor taught by Boyadjian to the severing station C taught by Fabrig for the purpose of providing a more precise control over the length of the wire binding element to prevent edges or ends thereof from projecting at the edges of the bound sheets, thus preventing the wire binding element from getting caught or causing injury, as explicitly taught by Boyadjian, see col. 1, lines 20-23, for example.

Response to Arguments

12. Many of Applicant's arguments with respect to the new claims have been considered but are moot in view of the new ground(s) of rejection. However, Examiner will address any remarks to the extent that they are still applicable. It is also noted that many of the remarks directed to specifics of the new claim language are addressed in the above prior art rejections.

13. Firstly, re the Fabrig reference applied to the claims, Applicant appears to be asserting that the language "producing at least one wire binding element with a random loop length and loop distance as required" limits the claims to a method including a step wherein a plurality of various sizes (and specifically a plurality of different loop lengths and loop distances) of loops are produced. However, it is noted that the claims do not actually set forth any such method step of producing a plurality of different or varied loop lengths or loop distances in the wire binding elements. Note that, as broadly claimed, whatever loop length and distance is selected and produced (in, for example, the Fabrig reference) is, broadly speaking, a "random" loop length and distance (i.e., the end user chose it for their application) that is desired or required. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

14. Applicant makes a number of remarks about the capability of the present invention to manufacture individual rather than mass-produced products. Firstly, it is noted that no claim language that would provide any distinction in this regard has yet been provided. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Secondly, it is noted that merely providing a binding process wherein various sizes can be produced would not appear to define over the prior art, noting, for example, that Fabrig's process "can" be adapted to produce whatever sized articles as are desired, at the very least, by providing the appropriate tooling to the machines to do so. It is also noted that the use of computer control, per se, of a known machine, is not a patentable feature as the use of such computer controllers to control one or more manufacturing processes/devices is extremely well-known, and even has an entire class (700) in the United States Manual of Classification dedicated thereto.

15. Applicant also comments that the "prefabrication of the C-shaped binding strips is carried out in other stations which are remote from the binding system (see the abstract and Fig. 1 of Fabrig)".

However, firstly, Fabrig teaches an in-line process (as shown in Figure 1) that is similar to the schematic showing of such process steps in Figure 1 of the present invention, wherein the "prefabrication" of the binding strips" is carried out in "station" 40" and then the binding strips are conveyed via conveyor 50 to an insertion device 80 and a bending/closing device 90 (see present Figure). Fabrig's process is similar, noting that the "prefabrication" of the wire binding elements occurs in stations A, B and C, and the cut and formed wire binding elements are conveyed to the binding station G (see at least Figure 1).

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Secondly, the only claim language that appears to relate to this comment is that the wire binding element is tailored to a respective format and thickness of a brochure “immediately prior to a binding process”. It is noted that the “tailoring” (see the above prior art rejections with respect to the breadth and interpretation of this terminology) in at least stations A, B, and C is considered, as broadly claimed, to occur “immediately prior” to the binding process (see at least Figure 1).

Note that in the Fabrig process, the binding process occurs “in-line” with the “tailoring” operations, and is thus, in at least that sense, to occur “immediately prior” to the binding process.

Furthermore, note that the term “immediately prior”, per se, is broad enough to encompass a large frame of time. Note that in a manufacturing process, one manufacturer may form or “tailor” the binding element in a ‘just-in-time’ processing environment (wherein the element is formed in sequence with its demand). During such a process, a manufacturer may need a particular element (such as a binding element) to complete his pre-determined product (in this case, the brochures). A different manufacturer (who forms the binding element) knows the pre-determined number, and will form the element just as it is needed. Since applicant has not disclosed specific details of what constitutes “immediately prior” and its relative time frame, the term is given its broadest reasonable interpretation, to include the in-line process taught by Fabrig, to include a few minutes worth of time, or even possibly to include a day prior to the formation of the brochure, as such could be considered “immediately prior” in a ‘just-in-time’ processing environment.

16. Applicant has asserted that new claims 22-32 that were presented in the amendment of August 28, 2007 “have the same scope as claims 1-9 of issued European Patent EP 1 211 098

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B1, corresponding to the instant application”, and that such were presented “[I]n order to make the differences between the invention of the instant invention and Fabrig even clearer”.

Examiner notes that the prosecution of a patent application, and specifically, of the determination of the patentability of particular claims of a patent application, in an office other than the United States Patent & Trademark Office is irrelevant to such a determination in the United States Patent & Trademark Office. Note, for example, that the laws and rules that govern such a determination before the U.S.P.T.O. are United States laws and rules, which are not identical to such laws and rules in other venues.

Conclusion

17. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

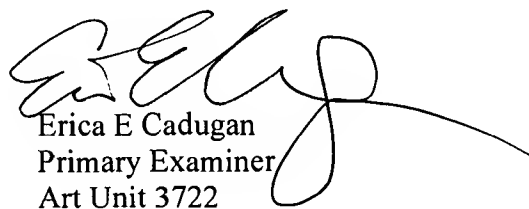
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Erica E. Cadugan whose telephone number is (571) 272-4474. The examiner can normally be reached on M-F, 6:30 a.m. to 4:00 p.m., alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Monica S. Carter can be reached on (571) 272-4475. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Erica E Cadugan
Primary Examiner
Art Unit 3722

eec
November 8, 2007